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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/735,218 | 12/12/2003 | Robert E. Shostak | 2101418-991102 | 1759 |
| 26379 | 7590 | 03/06/2006 | EXAMINER WEST, LEWIS G | |
| DLA PIPER RUDNICK GRAY CARY US, LLP 2000 UNIVERSITY AVENUE E. PALO ALTO, CA 94303-2248 | | | ART UNIT 2682 | |

DATE MAILED: 03/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/735,218

Applicant(s)

SHOSTAK, ROBERT E.

Examiner

Lewis G. West

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 52-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 52-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1 page.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 52-55 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 52-55 of copending Application No. 11/070,336. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claims 52-55 of this application conflict with claims 52-55 of Application No. 11/070,336. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 52-55 are rejected under 35 U.S.C. 102(b) as being anticipated by Yacenda et al (US 5,514,426).

Regarding claim 52, Yacenda discloses a system for locating a user of a wireless communications system wherein the wireless communications system has a central computer connected to one or more access points which communicate wirelessly with a badge associated with a user (Col. 2 lines 16-32), the system comprising: means for determining the current access point being used for communications by the badge of the user being located (Col. 4 lines 44-62); and means for generating a location indicator for the user wherein the location indicator is the name and location of the access point currently being used by the user. (Col. 14 lines 16-36)

Regarding claim 53, Yacenda discloses a method for locating a user of a wireless communications system wherein the wireless communications system has a central computer connected to one or more access points which communicate wirelessly with a badge associated with a user (Col. 2 lines 16-32), the method comprising: receiving a request to locate a user of the wireless communications system (Col. 14 lines 14-23); determining the access point currently being used for communications by the badge of the user (Col. 14 lines 24-31); and generating a location indicator for the user wherein the location indicator is the name and location of the access point being used by the user. (Col. 14 lines 32-36)

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Regarding claim 54, Yacenda discloses a system for locating a member of a group of a wireless communications system wherein the wireless communications system has a central computer connected to one or more access points which communicate wirelessly with one or more badges associated with one or more members of the group (Col. 2 lines 16-32), the system comprising: means for determining the current access point(s) being used (Col. 4 lines 44-62) for communications by the badge(s) of the one or more members of the group specified by a group location request (Col. 16 lines 1-20); and means for generating a location indicator for the member in the group (Col. 8 lines 31-59), wherein the location indicator is the name and location of the access point currently being used by the member of the particular group (Col. 16 lines 27-31).

Regarding claim 55, Yacenda discloses a method for locating a member of a group of a wireless communications system (Col. 15 lines 56-67) wherein the wireless communications system has a central computer connected to one or more access points which communicate wirelessly with one or more badges associated with one or more members of the group (Col. 2 lines 16-32), the method comprising: receiving a request to locate a member of a group of the wireless communications system (Col. 16 lines 1-20); determining the current access point(s) being used for communications by the badge(s) of the one or more members of the group specified by a group location request (Col. 16 line 20-23); generating a location indicator for the members in the group wherein the location indicator is the name and location of the access point currently being used by the members of the group. (Col. 16 lines 27-31)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doris To can be reached on 571-272-7629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lewis West
(571) 272-7859